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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,588	07/25/2003	Shinichi Yamamura	03500.017426.	9756
5514 7590 03/28/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER INGBERG, TODD D	
			ART UNIT 2193	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			03/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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10/626588

EXAMINER

ART UNIT	PAPER
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20070321

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

As a courtesy the Examiner (Ingberg) sent a FAX to the Attorney informing them that their response period to the Office action was due soon. The Attorney called the Examiner and informed him the Office action was not received. The following needs to occur.

1. The Period for Response needs to be Reset
2. The action needs to be re-mailed.

Todd Ingberg
Primary Examiner
Art Unit: 2193

Office Action Summary	Application No.	Applicant(s)	
	10/626,588	YAMAMURA ET AL.	
	Examiner	Art Unit	
	Todd Ingberg	2193	

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 20 and 21 is/are rejected.
- 7) ☐ Claim(s) 9 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/4/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1 – 21 have been examined.

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The Information Disclosure Statement filed June 4, 2004 has been considered.

Specification

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
4. The preliminary amendment filed June 18, 2004 has been entered.

Drawings

5. The new formal drawings filed June 16, 2004 have been accepted.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 – 11 and 21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The current focus of the Patent Office in regard to statutory inventions under 35 U.S.C. § 101 for method claims and claims that recite a judicial exception (software) is that the claimed invention recite a practical application. Practical application can be provided by a physical transformation or a useful, concrete and tangible result. No physical transformation is recited and additionally, the final result of the claim is

for installing software which is not a tangible result because the result is not clearly and concisely claimed to be stored on a computer readable medium. The following link on the World Wide Web is for the United States Patent And Trademark Office (USPTO) policy on 35 U.S.C. §101.

http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf

Claims 1 – 21 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. The word “*can*” in the independent claims, means and is able to perform and it also may not perform. Not performing lacks utility. The word should be removed.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1 – 7, 9 - 17 and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN # 6,289,396 B1 Keller et al filed November 21, 1995 (referred to as **DDD**).

Claim 1

DDD anticipates an information processing apparatus which can install a first control program corresponding to a first peripheral device and a second control program for controlling a second peripheral device, the first and second control programs including a common module, said apparatus comprising: deciding means for deciding identification information of the common module so that the identification information of the common module which operates as a part of said first control program and the identification information of the common module which operates as a part of said second control program are made different.

Rejection for claim 1

DDD provides an overview of the process in the Abstract (an information processing apparatus). can install a first control program corresponding to a first peripheral device (**DDD**, Figures 3 and 4) and a second control program for controlling a second peripheral device (**DDD**, Figures 3 and 4), the first and second control programs including a common module (**DDD**, col 4, lines 25 – 35, separation with objects), said apparatus comprising: deciding means for deciding

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identification information of the common module (DDD, Col 3, lines 51 – 61) so that the identification information of the common module which operates as a part of said first control program and the identification information (DDD, col 14, 40 – 65) of the common module which operates as a part of said second control program are made different (DDD, Fig 3, #94, 96, 98, Unique ID).

Claim 2

An apparatus according to claim 1, further comprising installation control means for installing the common module of said first control program and said second control program for controlling said peripheral devices as different modules so as to correspond to said first peripheral device and said second peripheral device on the basis of each of the identification information decided by said deciding means, respectively.

Rejection for claim 2

An apparatus according to claim 1, further comprising installation control means for installing the common module of said first control program and said second control program for controlling said peripheral devices as different modules so as to correspond to said first peripheral device and said second peripheral device on the basis of each of the identification information (as per claim 1) decided by said deciding means, respectively (DDD, Fig 3, #94, 96, 98, Unique ID).

Claim 3

An apparatus according to claim 1, wherein said deciding means decides the identification information of the common module which operates as a part of said first control program on the basis of information showing said first peripheral device and decides the identification information of said common module which operates as a part of said second control program on the basis of information showing said second peripheral device, respectively.

Rejection for claim 3

An apparatus according to claim 1, wherein said deciding means decides the identification information of the common module which operates as a part of said first control program on the basis of information showing said first peripheral device and decides the identification information of said common module which operates as a part (DDD, Figure 3) of said second control program on the basis of information showing said second peripheral device (As per claim 1), respectively.

Claim 4

An apparatus according to claim 1, further comprising forming means for forming identification information having uniqueness in response to execution of installation of the control program, and wherein said deciding means decides the identification information of said common module which operates as a part of said first control program and the identification information of said common module which operates as a part of said second control program on the basis of the information having the uniqueness formed by said forming means, respectively.

Rejection for claim 4

An apparatus according to claim 1, further comprising forming means for forming identification information having uniqueness in response to execution of installation of the control program

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(DDD, Fig 3, #94, 96, 98, Unique ID), and wherein said deciding means decides the identification information of said common module which operates as a part of said first control program and the identification information of said common module which operates as a part of said second control program on the basis of the information having the uniqueness formed by said forming means (Claim 2 – API), respectively.

Claim 5

An apparatus according to claim 1, wherein the identification information of said common module is a name of said common module which is managed by an operating system which is installed in said information processing apparatus, and said apparatus further comprises control means for controlling said operating system so as to change the names of the common modules corresponding to the peripheral devices on the basis of each of the identification information decided by said deciding means.

Rejection for claim 5

An apparatus according to claim 1, wherein the identification information of said common module is a name of said common module which is managed by an operating system (DDD, Fig 3, #93, 90 and Fig 9, #54) which is installed in said information processing apparatus, and said apparatus further comprises control means for controlling said operating system so as to change the names of the common modules corresponding to the peripheral devices on the basis of each of the identification information decided by said deciding means (DDD, Fig 3, #94, 96, 98, Unique ID)

Claim 6

An apparatus according to claim 1, further comprising recognizing means for recognizing a module which is continuously loaded into an operating system among said common modules, and wherein in order to selectively change the identification information of the common modules recognized by said recognizing means, said deciding means decides the identification information of said common modules obtained after the change.

Rejection for claim 6

An apparatus according to claim 1, further comprising recognizing means for recognizing a module which is continuously loaded into an operating system among said common modules (DDD, col 13, lines 53-65), and wherein in order to selectively change the identification information of the common modules recognized by said recognizing means, said deciding means decides the identification information of said common modules obtained after the change (DDD, col 14, lines 40-70).

Claim 7

An apparatus according to claim 1, wherein in response to execution of installation, said deciding means decides the identification information of said common modules on the basis of identification information having uniqueness which is formed as unique identification information upon said installation.

Rejection for claim 7

An apparatus according to claim 1, wherein in response to execution of installation, said deciding means decides the identification information of said common modules on the basis of

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identification information having uniqueness (DDD, Determine, Fig 3, #10) which is formed as unique identification information upon said installation (DDD, Fig 3, #94, 96, 98, Unique ID).

Claim 10

An apparatus according to claim 7, wherein said deciding means decides the identification information of said common modules on the basis of a set of said identification information having the uniqueness and said first peripheral device or a set of said identification information having the uniqueness and the identification information showing said second peripheral device.

Rejection for claim 10

An apparatus according to claim 7, wherein said deciding means decides the identification information of said common modules on the basis of a set of said identification information having the uniqueness and said first peripheral device or a set of said identification information having the uniqueness and the identification information showing said second peripheral device (DDD, Figure 3, #106, 107 108 and col 14, lines 41 – 65).

Claim 11

An information processing method in which a first control program corresponding to a first peripheral device and a second control program for controlling a second peripheral device can be installed, the first and second control programs including a common module, said method comprising: a deciding step of deciding identification information of the common module so that the identification information of the common module which operates as a part of said first control program and the identification information of the common module which operates as a part of said second control program are made different. As per the rejection for claim 1.

Claim 12

A method according to claim 11, further comprising an installation control step of installing the common module of said first control program and said second control program for controlling said peripheral devices as different modules so as to correspond to said first peripheral device and said second peripheral device on the basis of each of the identification information decided in said deciding step, respectively. As per the rejection for claim 2.

Claim 13

A method according to claim 11, wherein in said deciding step, the identification information of the common module which operates as a part of said first control program is decided on the basis of information showing said first peripheral device and the identification information of said common module which operates as a part of said second control program is decided on the basis of information showing said second peripheral device, respectively. As per the rejection for claim 3.

Claim 14

A method according to claim 11, further comprising a forming step of forming identification information having uniqueness in response to execution of installation of the control program, and wherein in said deciding step, the identification information of said common module which operates as a part of said first control program and the identification information of said common

module which operates as a part of said second control program are decided on the basis of the information having the uniqueness formed in said forming step, respectively. As per the rejection for claim 4.

Claim 15

A method according to claim 11, wherein the identification information of said common module is a name of said common module which is managed by an operating system, and said method further comprises a control step of controlling said operating system so as to change the names of the common modules corresponding to the peripheral devices on the basis of each of the identification information decided by said deciding step. As per the rejection for claim 5.

Claim 16

A method according to claim 11, further comprising a recognizing step of recognizing a module which is continuously loaded into an operating system among said common modules, and wherein in said deciding step, in order to selectively change the identification information of the common modules recognized by said recognizing step, the identification information of said common modules obtained after the change is decided. As per the rejection for claim 6.

Claim 17

A method according to claim 11, wherein in said deciding step, in response to execution of installation, the identification information of said common modules is decided on the basis of identification information having uniqueness which is formed as unique identification information upon said installation. As per the rejection for claim 7.

Claim 20

A method according to claim 17, wherein in said deciding step, the identification information of said common modules is decided on the basis of a set of said identification information having the uniqueness and said first peripheral device or a set of said identification information having the uniqueness and the identification information showing said second peripheral device. As per the rejection for claim 10.

Claim 21

A computer-readable memory medium which stores a control program for controlling an information processing apparatus which can install a first control program corresponding to a first peripheral device and a second control program for controlling a second peripheral device, the first and second control programs including a common module, wherein said control program comprises a deciding step of deciding identification information of the common module so that the identification information of the common module which operates as a part of said first control program and the identification information of the common module which operates as a part of said second control program are made different. As per the rejection for claim 1.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN # 6,289,396 B1 Keller et al filed November 21, 1995 (referred to as **DDD**) in view of USPN # 6,804,233 B1 Congdon filed November 14, 2000 which is a continuation filed July 8, 1997 (referred to as **MAC**).

Rejection for Claims 8 and 18

DDD teaches the unique common address (as per the claim 1). But **DDD** does not explicitly the address is a MAC address. It is **MAC** who teaches setting a common unique address (MAC, Abstract) that is a MAC address (MAC, Abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine DDD with MAC, because implementing devices with MAC addresses enables the use of devices with NIC cards.

Claim 8

An apparatus according to claim 7, wherein said identification information having the uniqueness is formed on the basis of an MAC address.

Claim 18

A method according to claim 17, wherein said identification information having the uniqueness is formed on the basis of an MAC address. As per the rejection for claim 8.

Allowable Subject Matter

11. Claims 9 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. (Please, note the 101 rejection remains.)

Claim 9

An apparatus according to claim 7, wherein said identification information having the uniqueness is formed on the basis of time information showing time when the installation is executed.

Claim 19

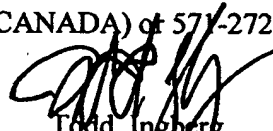
A method according to claim 17, wherein said identification information having the uniqueness is formed on the basis of time information showing time when the installation is executed.

Correspondence Information

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd Ingberg whose telephone number is (571) 272-3723. The examiner can normally be reached on during the work week..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571) 272-3719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Todd Ingberg
Primary Examiner
Art Unit 2193

TI